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**OFFICE OF PETITIONS**

In re Application of	:	
Goronzy et al.	:	DECISION ON APPLICATION
Application No. 09/723,000	:	FOR
Filed: November 27, 2000	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 07039-170002	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(B)," filed January 5, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to three hundred fifty (350) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred fifty (350) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On October 6, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On January 5, 2005, applicants timely submitted an application for patent term adjustment (with required fee)<sup>1</sup>. Applicants dispute the period of adjustment for Office failure to mail a first action under 35 U.S.C. 132. Applicants maintain that in accordance with 37 C.F.R. 1.703, the period of adjustment for Office delay in mailing the first Office action under 35 U.S.C. 132 is 477 days.

<sup>1</sup> PALM records indicate that the Issue Fee was also received on January 5, 2005.

Specifically, applicants state that such action was mailed on May 19, 2003, 477 days after the fourteen-month date. Applicants contend that the communication mailed July 2, 2002, is not a first action on the merits as provided in 35 USC §132, and thus, does not meet the requirement of 35 U.S.C. §154(b)(1)(A)(i) of the PTO to mail at least one of either a notification under 35 U.S.C. §132 or a notice of allowance for patent term adjustment calculation purposes in 37 CFR §1.703(a)(1). Moreover, applicants state that their response to the Office communication mailed July 2, 2002, was mailed to the Office on July 15, 2002 (and received on July 22, 2002), and thus, there was no applicant delay associated with this response.

The record supports a conclusion that the patent issuing from the application is not subject to a terminal disclaimer.


A review of the application history confirms that applicants' characterization of the basis for and amounts of the adjustments and reductions of patent term in this application are correct.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred fifty (350) days (477 days of Office delay reduced by 127 days for Applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

  
Karin Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Attachment: Copy of Revised PAIR Screen